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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,248	03/08/2001	Thomas E. Chefalas	YOR920000718US1 (14031)	5564
7590 09/01/2004			EXAMINER	
Richard L. Catania Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			NELSON, FREDA ANN	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/802,248

Applicant(s)

CHEFALAS ET AL.

Examiner

Freda Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This is in response to a letter for a patent filed on March 8, 2001 in which claims 1-31 were presented for examination. Claims 1-31 are pending.

#### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 832 and because they include the following reference character(s) not mentioned in the description: 516. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the inventive conceptive in claims 1-27 only recite an abstract idea. The recited steps of merely acquiring customer information at the time of purchase and generating product registration information for a manufacturer and transmitting the information to the manufacturer does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper

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and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma* ( CCPA 197 USPQ 852 (1978)).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-27 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1- 4, 8, 19, 21- 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers et al. (Patent No. 6,018,719).

6. In claims 1- 4 and 8, Rogers et al. discloses an electronic product registration that enables individual product identification information to be gathered at the point of a transaction for inclusion of one or more transaction databases. Rogers et al. discloses that the electronic registration begins when the customer brings the merchandise to the register which is connected to a local computer system (see Fig 2). Rogers et al. further discloses that upon validation of a product serial number; the customer sales receipt is printed; the transaction

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databases are updated; the local computer extracts the serial number from the local database and batches the information. The retailer computer system then dials the manufacturer's computer system and transmits the data to the electronic mailbox of the manufacturer (col. 6, lines 44-59).

7. In claims 19 and 21-22 Rogers et al. discloses a system for providing an electronic product registration that enables individual product identification information to be gathered at the point of a transaction for inclusion of one or more transaction databases. Rogers et al. discloses that the individual product identification information is stored in a local transaction database (col.2, lines25-29). Rogers et al. discloses a system in which the transaction databases are updated after sales transaction are completed (col. 6, lines 30-34). Rogers et al. discloses that when the sale is completed, the customer is given the sales receipt which includes descriptions and SKUs of the purchased products. Rogers et al. further discloses that the retailer computer system dials the manufacturer's computer system and transmits the data from the receipt to the electronic mailbox of the manufacturer (col. 6, lines 44-59).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claim 5, 9-11, 20, 25, 27, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al (Patent No. 6,018,719) in view of Kirkpatrick et al. (US PG Pub. 2001/00420022).

10. In claim 5, Rogers et al. does not disclose that customer information is provided to register a product. Kirkpatrick et al discloses that the acquired customer information includes the name, address, and phone number of the customer (see fig. 2 and paragraph 0031). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the customer to input their information in order to have a more detailed record of the sales transaction.

11. In claims 9-11, 27 and 29, Rogers et al. does not disclose that the customer logs onto the manufacturer's website to complete the product registration process. Kirkpatrick et al. discloses that an on line form may be generated by logging on to the manufacturer's website; and upon completion of the form the information returned from the consumer may be processed by the server to generate and e-mail a registration notice to the manufacturer. The server may also forward a confirmation of the product registration back to the consumer. (see abstract, fig.1, and paragraphs 0008 and 0017). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the registration process of Rogers et al to include the on line product registration process of Kirkpatrick et al to promote a more convenient and efficient way of registering products. Kirkpatrick et al is silent about the customer

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indicating a product is a gift to a donee. Kirkpatrick is also silent about the donee later updating and completing product registration, however, it is deemed to be inherent that if a gift is purchased for a donee, the donee should be permitted to register the product at another time other than at the time of purchase

12. In claim 20, Rogers et al. discloses that product registration information includes product information relating to one or more products (col. 6, lines 1-2). Rogers et al. does not disclose that the product registration information includes customer information relating to the customer. Kirkpatrick et al discloses that product registration information includes customer information relating to the customer. (see fig. 2, fig. 3 and paragraphs 0016). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the limitation of customer information relating to the customer as disclosed in Kirkpatrick et al. with the product registration information of Rogers et al. to provide a more detailed record of the product registration.

13. In claim 25, Rogers et al. does not disclose a system wherein the manufacturers have a website for the customer to complete product registration, however, Kirkpatrick discloses a system 10 wherein an online retailer 14 may present the consumer 12 with Web pages 20 to register a product (fig 1 and Paragraph 0222). It would have obvious to one of ordinary skill in the art at the time the invention was made to modify the registration system of Rogers et al. to include the system disclosed in Kirkpatrick et al. in order to allow the customer the convenience of registering the purchased product at a later time other than the point of sale.



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14. In claim 31, Rogers et al. discloses a system for providing an electronic product registration that enables individual product identification information to be gathered at the point of a transaction for inclusion of one or more transaction databases. Rogers et al. discloses that the individual product identification information is stored in a local transaction database (col.2, lines 25-29). Rogers et al. discloses a system in which the transaction databases are updated after sales transactions are completed (col. 6, lines 30-34). Rogers et al. discloses that discloses that when the sale is completed, product registration information (description, SKU) is printed on the customer's sales receipt. Rogers et al. further discloses that the retailer computer system dials the manufacturer's computer system and transmits the data from the receipt to the electronic mailbox of the manufacturer (col. 6, lines 44-59). Rogers et al. does not disclose that customer information is acquired at the time of purchase, however, Kirkpatrick et al. discloses that customer information is acquired at the time of customer purchased (Fig. 2). It would have obvious to one of ordinary skill in the art at the time the invention was made to include the step of acquiring customer information as disclosed in Kirkpatrick et al. with the electronic product registration process of Rogers et al. to provide a more detailed product registration form and sales receipt.

15. Claims 12, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. in view of Kirkpatrick et al. in view of Rydbeck (Patent No. 6,240,286).

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16. In claims 12 and 26, Rogers et al. does not disclose that the customer completes product registration by establishing contact with a voice response unit (VRU) associated with the manufacturer. Rydbeck discloses that a customer establishes a connection with the Voice Response Unit (VRU) server at the warranty registration center (col. 6, lines 10-12). Rogers et al. does not disclose that the VRU obtains the customer's phone number and retrieves product registration information based on that customer's phone number. Rydbeck discloses that the VRU instructs the user to depress a particular keyboard character. When the key is depressed, the electronic logic within the customer's phone notes the depression and is interpreted as permission to proceed. Rogers et al. does not further disclose that the VRU communicates information to the customer necessary for the completion of the product registration. Rydbeck discloses that the VRU instructs the user to depress a second character and when the logic within the phone detects the second entry, the status-flag is set, denoting successful warranty registration. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the completion step of Rogers et al to include the registration steps disclosed in Rydbeck to allow a more secure point of sale product registration.

17. In claims 28-30, Rogers et al does not disclose that a personal computer and telephone is used to complete product registration. Rogers et al. does not further disclose that the communication system of the product registration system includes an Internet, Intranet and a telecommunications network. Kirkpatrick discloses a system 10 wherein an online retailer 14 may present the consumer

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12 with Web pages 20 to register a product (fig 1 and Paragraph 0222).

Rydbeck discloses that a customer establishes a connection with the Voice Response Unit (VRU) server at the warranty registration center (col. 6, lines 10-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the registration process of Rogers et al. to include the on line registration system with the phone registration of Rydbeck to provide a more flexible way of registering products by allowing the customer to register by computer or telephone.

18. Claims 6-7 and 13-18 are rejected under 35 U.S.C 103 (a) as being unpatentable over Rogers et al. in view of Kirkpatrick et al. in view of Rydbeck and in further view of Jalili (Patent No. 6,088,683).

19. In claims 6-7 and 23-24, Rogers et al. and Kirkpatrick et al. does not disclose a method or device for utilizing a telephone number provided by the customer at the time of the purchase for retrieving customer information from a directory listing service. Kirkpatrick et al discloses that the acquired customer information includes the name, address, and phone number of the customer (see fig. 2 and paragraph 0031). Rogers et al. and Kirkpatrick et al. does not disclose manually entering customer information by seller if customer information cannot be retrieved from a directory listing service, however, it is deemed inherent that if customer information can not be retrieved from a directory listing service, the customer information has to entered manually prior to or during product registration.

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20. In claims 13-15, Kirkpatrick et al. does not disclose associating a telephone keypad number key with a manufacturer's product for transmission. Rydbeck discloses that the phones keyboard character is depressed to complete registration. Jalili discloses that when the mode of interaction is through a voice response unit, the buyer will use the telephone keypad to respond to choices presented by the system (col.2, lines 60-65). It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the registration of Rogers et al. with Rydbeck and Jalili in order to allow a more secure way of registering products.

21. In claims 16-18, Rogers et al. and Kirkpatrick et al. does not disclose utilizing a telephone number provided by the customer at the time of the purchase for retrieving customer information from a directory listing service. Jalili discloses that a processing center can verify a customer's credit card registration and purchases by the use of the telephone's CallerID function (col.1 line 66 –col. 2, line 1). Jalili discloses that when the mode of interaction is through a voice response unit, the buyer will use the telephone keypad to respond to choices presented by the system (col.2, lines 60-65). Rydbeck discloses that a customer establishes a connection with the Voice Response Unit (VRU) server at the warranty registration center (col. 6, lines 10-12). It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the registration method of Rogers et al. to include Jalili's use of the CallerID function to secure purchase transactions with the acquired customer information disclosed in Kirkpatrick et al. to provide a more efficient way to register products.

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Rydbeck does not disclose that the customer enters the customer's telephone number manually, however, it is inherent that the customer enters their phone number if their phone number is not obtained by the VRU.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda Nelson whose telephone number is (703) 305-0261. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Freda Nelson  
Examiner  
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